REMARKS

Claims 1-15 were pending in the Application. Claim 1 is an independent claim and claims 2-10 depend therefrom. Claim 11 is an independent claim and claims 12-15 depend therefrom. Claims 16-22 were previously canceled. Claims 1 and 11 are currently amended. Applicant respectfully requests reconsideration of the application in light of the above-mentioned amendments and the following remarks.

Rejections Under 35 U.S.C. §101 (Claims 1-15)

On Pages 2-3 of the Office Action, claims 1-10 were rejected under 35 U.S.C. § 101, "as not falling within one of the four statutory categories of invention." (Office Action, Page 2). Specifically, the Office Action stated that "a statutory 'process' under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing." (Office Action, Page 2). As an initial matter, the Applicant notes that claim 1 recites, among other elements, "replacing the standard definition video stream with the at least one high definition video data stream to produce a high definition video data signal." This clearly involves a transformation, and the rejection should be withdrawn for this reason alone. Nevertheless, in an effort to advance prosecution, the Applicant has amended claim 1 to include the limitation "performing by at least one circuit...." Thus, the Applicant respectfully submits that Applicant's independent claim 1 meets the requirements of 35 U.S.C. § 101 for the additional reason that the process of Applicant's independent claim 1 is at least tied to a machine (i.e., "at least one circuit"). The Applicant notes that claims 2-10 depend directly or indirectly from independent claim 1. Therefore, the Applicant respectfully requests that the rejections of claims 1-10 under 35 U.S.C. § 101, be withdrawn.

On Page 3 of the Office Action, claims 11-15 were rejected under 35 U.S.C. § 101, because "taking the claim as a whole, the steps recited nothing more than a manipulation of data,

i.e., (abstract idea)." (Office Action, Page 3). However, the Applicant first notes that the Office Action has not established a *prima facie* case of unpatentability since the Examiner has not identified and explained **"the basis for why a claim is for an abstract idea with no practical application." Accordingly, the burden has not shifted to the Applicant to either amend the claim or make a showing of why the claim is eligible for patent protection.** *See*, In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). *See also*, generally, MPEP § 2107.

Second, the Applicant notes that the Applicant's independent claim 11 is neither "steps" nor "abstract idea[s]" as alleged in the Office Action. Rather, Applicant's independent claim 11 sets forth "[a]n apparatus for use in producing a high definition video data signal, comprising: a high definition program stream demuxer...; a generator...; a muxer...; a video scaler...; a video mixer...; and an encrypter...." Clearly, the above-mentioned apparatus components (i.e., demuxer, generator, muxer, video scaler, video mixer and encrypter) are neither "steps" nor "abstract ideas" as alleged in the Office Action. Rather, as acknowledged by the Office Action, "claims 11-15 [ ] recites an apparatus for use in producing high a definition video data signal which falls within one of the four categories of subject matter." (Office Action, Page 3).

Third, even if Applicant's independent claim 11 did somehow contain abstract idea(s) (which it clearly does not), the Applicant notes that Applicant's independent claim 11 clearly sets forth a practical application (i.e., a useful, concrete and tangible result). The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. *See* MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 11-15 provides a practical application that produces a useful result, i.e., [a]n apparatus for use in producing a high definition video data signal.** Furthermore, as discussed above, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that the claims specifically set forth a practical application to produce a real-world result.

With regard to concrete results, since an appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

The Applicant points out that the preamble of independent claim 11 specifically recites the utility of Applicant's claims, i.e., for use in producing high a definition video data signal. At least for the above reasons, the Applicant believes that claims 11-15 comprise patentable subject matter and are believed to be allowable.

The Applicant notes that claims 12-15 depend directly or indirectly from independent claim 11. Therefore, because (1) claims 11-15 fall into one of the four categories of patentable subject matter, (2) the Applicant's claimed apparatus components are clearly not abstract ideas, (3) the Applicant's claimed apparatus components are clearly a practical application (i.e., a useful, concrete and tangible result), and (4) the Office Action failed to establish a *prima facie* case of unpatentability due to its mere conclusory statement, the Applicant respectfully requests that the rejections of claim 11-15 under 35 U.S.C. § 101, be withdrawn.

Final Matters

The Office Action makes various statements regarding claims 1-15, 35 U.S.C. § 101, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicant will not address all of such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements

should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 1-15 should the need arise in the future.

CONCLUSION

Applicant respectfully submits that all of claims 1-15 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: May 18, 2009

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